

REMARKS

In a final Office Action dated 27 January 2006, the Examiner rejects claims 1-44 (all pending claims). In response to the Office Action, Applicants amend claims 1-44. Applicants also respectfully traverse the rejections. Claims 1-44 remain in the application. In light of the amendments and the following arguments Applicants respectfully request that this application be allowed.

Applicants have amended the claims to more precisely claim the subject matter that Applicants regard as this invention. No new matter is entered by these amendments.

In the Office Action, the Examiner rejects claim 1 under 35 U.S.C. §103 as being unpatentable over U.S. Patent Application Publication 2004/0249975 A1 on behalf of Tuck et al. (Tuck) in view of U.S. Patent number 5,732,071 issued to Saito et al. (Saito). In order to maintain a rejection the Examiner has the burden of providing evidence of prima facie obviousness. See MPEP §2143. See also In Re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In order to prove prima facie obviousness, the Examiner must provide evidence in the prior art of a motivation to combine or modify a reference, a reasonable expectation of success, and a teaching of each and every claimed element. *Id.* The Examiner has failed to provide a reference that teaches all the elements of claim 1.

Amended claim 1 recites a method performed by a client system in a network to receive a MAC address. In this case the fact that the preamble states that the method is performed by a client computer must be considered when reading the claim. Applicant has further amended the claims to specifically recite that the steps are performed by the client. Thus, Tuck does not teach any of the claimed elements as all of the processes performed are performed by a server and/or router. See Abstract. See also Paragraph 9.

Amended claim 1 recites that the client selects a MAC address and transmits a MAC address request frame for the address. These elements are not taught in Tuck. Instead, Tuck teaches a system in which a server receives MAC messages and assigns an address to a client based upon information received from the client. Thus, a client in the Tuck reference does not select an address and determine that the address is available because a server insures that the MAC address is available before the MAC address is assigned to a client. Thus, a client in Tuck does not have to perform a contention method of receiving an address as recited in amended claim 1. For this reason, Applicants respectfully request that the rejection of claim 1 be removed and amended claim 1 be allowed.

Saito also does not teach the elements of claim 1 as all of the processes disclosed in Saito are performed by a bridge device in a network. There is no disclosure in Saito of clients providing any process let alone the elements recited in amended claim 1. Thus Saito does not teach processes performed by a client.

Since neither Saito nor Tuck teaches any of the limitations of amended claim 1, the combination of the two references does not teach any of the combinations of claim 1. Thus, amended claim 1 is allowable over the references and Applicants respectfully request that the rejection of claim 1 be removed and amended claim 1 be allowed.

Amended claims 2-8 depend from amended claim 1. Thus, amended claims 2-8 are allowable for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the rejections of claims 2-8 be removed and amended claims 2-8 be allowed.

Amended claim 12 recites a client system that performs the method of claim 1. Thus, claim 12 is allowable for at least the same reasons as amended claim 1. Therefore,

Applicants respectfully request that the Examiner remove the rejection of claim 12 and allow amended claim 12.

Amended claims 13-19 depend from amended claim 12. Thus, amended claims 13-19 are allowable for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the rejections of claims 13-19 be removed and amended claims 13-19 be allowed.

Amended claim 23 recites a client system that performs the method of claim 1. Thus, amended claim 23 is allowable for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the Examiner remove the rejection of claim 23 and allow amended claim 23.

Claims 24-30 depend from amended claim 23. Thus, amended claims 24-30 are allowable for at least the same reasons as amended claim 23. Therefore, Applicants respectfully request that the rejections of claims 24-30 be removed and amended claims 24-30 be allowed.

Amended claim 34 recites client system software that performs the method of claim 1. Thus, amended claim 34 is allowable for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the Examiner remove the rejection of claim 34 and allow amended claim 34.

Amended claims 35-41 depend from amended claim 34. Thus, amended claims 35-41 are allowable for at least the same reasons as amended claim 34. Therefore, Applicants respectfully request that the rejections of claims 35-41 be removed and amended claims 35-41 be allowed.

The Examiner also rejects claim 9. The Examiner has failed to provide a reference that teaches all the elements of claim 9. In the Office Action, the Examiner rejects claim 1 under 35 U.S.C. §103 as being unpatentable over U.S. Patent Application Publication

2004/0249975 A1 on behalf of Tuck et al. (Tuck) in view of U.S. Patent number 5,732,071 issued to Saito et al. (Saito). In order to maintain a rejection the Examiner has the burden of providing evidence of prima facie obviousness. See MPEP §2143. See also In Re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In order to prove prima facie obviousness, the Examiner must provide evidence in the prior art of a motivation to combine or modify a reference, a reasonable expectation of success, and a teaching of each and every claimed element. Id.

Amended claim 9 recites a server that receives a request to use an address from a client, determines if the address is in use and sends a response indicating that the address is free for the client to use. Tuck does not teach these limitations. Instead, Tuck teaches a system in which the server selects an address for a client node and transmits the address to the client. Thus, there is no need in Tuck for a server that confirms an address as recited in amended claim 9. Thus, Tuck does not teach amended claim 9.

Saito also does not teach the method recited in claim 9 as Saito merely teaches a bridge device that monitors advertisements to determine the MAC addresses of connected devices. Thus, Saito does not teach the receiving and approving of a MAC address for a client as received in amended claim 9

Since neither Saito nor Tuck teaches the limitations of amended claim 9, the combinations of the references does not teach the limitations of amended claim 9. Thus, Applicants respectfully request that the rejection of claim 9 be removed and amended claim 9 be allowed.

Amended claims 10-11 depend from amended claim 9. Thus, amended claims 10-11 are allowable for at least the same reasons as amended claim 9. Therefore, Applicants respectfully request that the rejections of claims 10-11 be removed and amended claims 10-11 be allowed.

Amended claim 20 recites a client system that performs the method of claim 9. Thus, amended claim 20 is allowable for at least the same reasons as amended claim 9. Therefore, Applicants respectfully request that the Examiner remove the rejection of claim 20 and allow amended claim 20.

Amended claims 21-22 depend from amended claim 20. Thus, amended claims 21-22 are allowable for at least the same reasons as amended claim 20. Therefore, Applicants respectfully request that the rejections of claims 21-22 be removed and amended claims 21-22 be allowed.

Amended claim 31 recites a client system that performs the method of claim 9. Thus, amended claim 31 is allowable for at least the same reasons as amended claim 9. Therefore, Applicants respectfully request that the Examiner remove the rejection of claim 31 and allow amended claim 31.


Amended claims 32-33 depend from amended claim 31. Thus, amended claims 32-33 are allowable for at least the same reasons as amended claim 31. Therefore, Applicants respectfully request that the rejections of claims 31-33 be removed and amended claims 31-33 be allowed.

Amended claim 42 recites client system software that performs the method of claim 9. Thus, amended claim 42 is allowable for at least the same reasons as amended claim 9. Therefore, Applicants respectfully request that the Examiner remove the rejection of claim 42 and allow amended claim 42.

Amended claims 43-44 depend from amended claim 42. Thus, amended claims 43-44 are allowable for at least the same reasons as amended claim 42. Therefore, Applicants respectfully request that the rejections of claims 43-44 be removed and amended claims 43-44 be allowed.

If the Examiner has any questions regarding this response or the application in general, the Examiner is invited to telephone the undersigned at 775-586-9500.

Respectfully submitted,  
SIERRA PATENT GROUP, LTD.

A handwritten signature in black ink, appearing to read 'W. Wilbar', is written over the printed name.

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